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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/789,605 | 02/27/2004 | Hanfang Pan | 030475 | 9037 |

23696 7590 10/10/2008
QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

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| EXAMINER |
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TORRES, JOSEPH D

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| ART UNIT | PAPER NUMBER |
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2112

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| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

10/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com
kascanla@qualcomm.com
nanm@qualcomm.com

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|------------------------------|--------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/789,605 | Applicant(s) PAN ET AL. | |
| | Examiner Joseph D. Torres | Art Unit 2112 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-19, 21, 22, 29-54 and 72-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-19, 21, 22, 29-35, 37-54 and 72-82 is/are allowed.
- 6) ☒ Claim(s) 36 and 83-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 09/03/2008 have been fully considered but they are not persuasive.

The Applicant contends, "Applicants respectfully submit that Claims 36 and 83-93 are directed to statutory subject matter. For example, claim 36 recites a "computer readable media comprising code for causing a computer to receive..." Applicants submit that as amended, claim 36 recites statutory subject matter. Thus, applicants submit that claim 36 is patentable. In addition, claims 83-93 depend, either directly or indirectly, from claim 36 and are also patentable".

The Examiner disagrees and asserts that Figure 2 in the Applicant's specification teaches that a signal 210 is a computer readable media. As such, the term "computer readable media", as written, encompasses signals. Signals with codes modulated onto the signal are non-statutory. In addition, the body of claims now recite that a "computer readable media" comprises a computer program or is a computer program. Computer programs are also non-statutory.

There are only four statutory categories of invention: process, machine, manufacture, or composition of matter. It is not clear, which of the statutory categories of invention the "computer readable media" falls into. Note: the claims cannot be a machine/apparatus/device, manufacture, or composition of matter since the body of the

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claims does not recite any structural element of a machine/apparatus/device, manufacture, or composition of matter. Furthermore, a “computer readable media” cannot be a process since media such as signals and computer software are not processes.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 36 and 83-93 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Figure 2 in the Applicant's specification teaches that a signal 210 is a computer readable media. Signals are non-statutory.

The Examiner asserts that Figure 2 in the Applicant's specification teaches that a signal 210 is a computer readable media. As such, the term “computer readable media”, as written, encompasses signals. Signals with codes modulated onto the signal are non-statutory. In addition, the body of claims now recite that a “computer readable media” comprises a computer program or is a computer program. Computer programs are also non-statutory.

There are only for statutory categories of invention: process, machine, manufacture, or composition of matter. It is not clear, which of the statutory categories of invention the “computer readable media” falls into. Note: the claims cannot be a machine/apparatus/device, manufacture, or composition of

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matter since the body of the claims does not recite any structural element of a machine/apparatus/device, manufacture, or composition of matter. Furthermore, a “computer readable media” cannot be a process since media such as signals and computer software are not processes.

Allowable Subject Matter

2. Claims 16-19, 21, 22, 29-35, 37-54 and 72-82 are allowed.

Conclusion

This is an RCE of applicant's earlier Application No. 10/789,605. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph D. Torres
Primary Examiner
Art Unit 2112

/Joseph D. Torres/
Primary Examiner, Art Unit 2112